



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,843	12/21/2001	Christopher Robert Carlson	31890/1613	4914

27433 7590 10/06/2003

FOLEY & LARDNER  
321 NORTH CLARK STREET  
SUITE 2800  
CHICAGO, IL 60610-4764

EXAMINER

NGUYEN, PHONG H

ART UNIT	PAPER NUMBER
----------	--------------

3724

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/036,843

Applicant(s)

CARLSON ET AL.

Examiner

Phong H Nguyen

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 31-35 is/are rejected.
- 7) ☒ Claim(s) 29 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1 lines 12-13, it is unclear whether the Applicant mentions the shapes' size of the upper template or the lower template.

3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding the phrase "a plurality of grooves", it is unclear whether the Applicant means a plurality of shapes or the pre-printed grid on the templates. The Examiner assumes that the Applicant means a plurality of shapes.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9, 12-21, 23-28, 31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (3,768,177) in view of Taylor (5,511,472) and Rasheed et al. (US Pub. 2002/0009695 A1).

Regarding claims 1, 2, 12, 13, 17 and 23, Thomas teaches a base 10 with pegs 19 capable of using as a base of an embossing system. See Fig. 1. Taylor teaches an embossing apparatus having an upper template and a lower template. See Figs. 1-5. Therefore, it would have been obvious to rest the templates as taught by Taylor on the base as taught by Thomas so that artists have a stable workplace to hold templates for embossing artworks. Thomas teaches artworks with textures in the background. See Fig. 1. Rasheed et al. teach texture plates for creating textures on artworks. See Fig. 2. Therefore, it would have been obvious to incorporate texture plates as taught by Rasheed et al. to the embossing apparatus as taught by Taylor to create background textures for an artwork.

Regarding claims 3 and 27, a scoring tool 18 is best seen in Fig. 2 in Taylor.

Regarding claims 4, 5 and 26, the upper template, the lower template and the texture plate are removably connected to the base.

Regarding claims 6, 18, 19 and 25, the upper and the lower template are hingedly coupled to each other. See Fig. 4 in Taylor.

Regarding claims 7, 14 and 24, a depressed portion of the base 10 is best seen in Fig. 1 in Thomas.

Regarding claims 8, 9, 20, 21, 28 and 31, Taylor does not teach a specific thickness of the upper and the lower template but teaches the effecting of thickness of the

templates on the worked paper. See col. 1, lines 20-25. Therefore, it would have been obvious to use templates with appropriate thickness to accommodate worked paper with different thickness or resiliency so that the worked paper would not be stretched beyond its breaking point during the embossing process.

Regarding claim 15, a stylus 19 is best seen in Fig. 2 in Taylor.

Regarding claim 16, Taylor teaches two pegs on the lower template and two holes on the upper templates in order to align the templates together. See Fig. 5. However, as one uses those templates with a base having two pegs for aligning templates as taught by Thomas, it would have been obvious to replace two pegs on the lower templates, as taught by Taylor, by two holes so that both templates can mate with the pegs.

Regarding claims 33-35, Taylor teaches providing a light box to create an outline of the cut-out on the paper to be embossed which acts as the guide for the embossing tool. See col. 1, lines 28-32. Therefore, it would have been obvious to provide the base as taught by Thomas a light source in order to create an outline of the cut-out on the paper.

6. Claims 10, 11, 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (3,768,177) in view of Taylor (5,511,472) and Rasheed et al. (US Pub. 2002/0009695 A1) as applied to claims above, and further in view of Carbone (6,216,354 B1). The combination of Thomas, Taylor and Rasheed does not teach providing grid pattern on the templates. Carbone teaches providing grid pattern 18 and 20 to help orient paper between the templates correctly. See Fig. 1 and col. 2, lines 31-35. Therefore, it would have been obvious to provide grid pattern on the templates as taught by Carbone to help artists orienting paper on the templates correctly.

***Allowable Subject Matter***

7. Claims 29 and 30 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Geddes (4,309,825), Volk (5,533,900), Harper (4,836,783) and Arad et al. (5,676,549) teach stencil and stencil kits of general interest.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H Nguyen whose telephone number is 703-305-4989. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

PN: *pn*

September 24, 2003

  
Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700